

Remarks

Claims 1-20 are pending in the above-identified application. Claims 1, 2, 10, 11, 16, 17 are amended and claims 3-9, 12-15, and 18-20 are original.

The Examiner rejected claims 1-20 under 35 U.S. C, 103(a) as being unpatentable over Nabkel et al (US Pat No. 5,999,613) in view of Epler et al (US Pat. No. 6,026,156), herein after referred as Nabkel and Epler.

MPEP §706.02(j) states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 states:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved, as a whole would have suggested to those of ordinary skill in the art.

In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

To establish a prima facie case of obviousness, it must be demonstrate that all of the following elements: 1) suggestion or motivation, either in the references themselves or in the knowledge of one of ordinary skill in the art, to combine the reference teachings; 2) reasonable expectation of success found in the prior art; and 3) the prior art references (combined) must teach or suggest all of the claim limitations.

The Examiner rejected claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Nabkel et al (US Pat No. 5,999,613) in view of Epler et al (US Pat. No. 6,026,156), herein after referred as Nabkel and Epler.

Regarding claim 1, referring to figure 2, the Examiner alleged that Nabkel teaches a call waiting method for use in a telecommunications network in which a first caller is engaged in a current call with a second caller, and for processing an incoming call from a third caller to the first caller, the method comprising the steps of:

providing identification of a plurality of callers in a predefined caller group (see fig. 2. and col. 2, line 51-col. 3, line 48);

detecting an incoming call from a third caller to a first caller, the first caller presently being engaged in a current call with a second caller (see fig. 2; and col. 2, Line 51 -col. 3, Line 48);

checking if the third caller is a member of the predefined caller group (see fig. 2; and col. 2, Line 51-col. 3, Line 48).

The Examiner admits that Nabkel fails to teach the steps of: signaling the third caller to leave a message to be sent to the first caller with a call waiting indication; recording a message from the third caller; and providing to the first caller a call waiting indication along with the recorder message from the third caller.

The Examiner then alleges that Epler teaches the above steps as expressed in figure 2, steps 82, 86, 90 and 92. The Examiner then concludes that integrating Epler's teachings into communication system of Nabkel would have been obvious for enabling the first caller to decide whether or not the on-going call should be interrupted.

Epler discloses a method of and apparatus for providing telecommunication services to a user. When the user is engaged in a first telephone call via a telephone switch with a first party and a second party attempts to place a second telephone call to the user via the switch, the method and apparatus advise the second caller that the user is engaged in a telephone conversation and allow the second caller to determine whether to interrupt the user or choose another alternative. The user can then decide whether to accept the call from the second caller, putting the first caller on hold, or to refuse the second call. Alternative embodiments are disclosed where the user is advised of the identity of the second caller (or wherein the user has previously authorized certain callers to interrupt a current call with a new call), and then the user can decide whether to accept the call from the second party (placing the first party on hold) or to deny the second party (in which case the second party is transferred to a message center).

Epler, in particular, teaches that the user, who is then engaged in a telephone call with a first person, will hear a distinctive call waiting tone which indicates the level of urgency or importance identified by the caller directly, or by the caller's CPID.

One advantage of the present method and system occurs when wireless subscribers use their phones while in an automobile or in transit. The convenience of having a short audio message relayed to them instead of a tone eliminates the need to pull the phone away from their face and look at the caller ID. This removes a distraction when the subscriber is driving a vehicle, for example. It also may eliminate the need to retrieve a voice mail message if the short announcement contains enough information that a message is not required. (page 6 of the specification)

In the specification of the present application as filed, it states that embodiments of the present method and system provide the capability for selected calling parties to record a short announcement message that will be used instead of the call waiting tone. (page 5 of the specification)

Also, in the specification of the present application as filed, it is explained that the MSC 600 signals to party C to leave a short message that will be used in the Call Waiting alert. (page 8 of the specification)

Also, in the specification of the present application as filed, it is explained that the improved present method and system further provides that the calling party can record a short message that may be used in addition to or instead of the normal call waiting tone. (page 13 of the specification)

Thus it is clear that, unlike the Epler teaching, the message in embodiments of the present invention is used instead of the normal call waiting tone. Epler teaches using the typical call waiting tone and then allowing the user to retrieve the message. Epler does not teach using the message instead of the normal call waiting tone. The independent claims have been amended to more clearly define this aspect of the present invention.

Each of independent claims 1, 10 and 16 have been amended as follows: "...providing to the first caller the recorded message as a call waiting indicator from the third caller..." The recorded message is the actual call waiting indicator rather than the known call waiting tone. Dependent claims 2, 11, 17 have been amended to claim the call waiting indicator further comprising at least one of a predetermined tone, an image, and a caller identification. For example, a tone, image or identification may be added to recorded message, but the recorded message is the call waiting indicator. That is, the subscriber, who is currently speaking with another person, would hear for example a third person say, "I need to talk with you now." The subscriber does not need to call up the message after hearing a tone as is the current practice, and as is taught by Epler.

Thus, Epler does not provide the teachings that the Examiner has identified as being deficient in Nabkel. Therefore, no combination of the cited prior art references results in Applicant's invention as claimed.

Regarding claims 2-5, 11 and 17, the Examiner referenced Nabkel, fig. 2; and col. 2, Line 51 -col. 3, Line 48. These claims are dependent claims that include all the limitations of the respective independent claims upon which they depend, and therefore, since the independent claims, as amended, have been shown to be allowable over the cited art, these dependent claims are also allowable over the cited art.

Regarding claims 6-9, 12-15 and 18-20, the Examiner referenced Epler, col. 10, Line 8-col. 11, Line 9. These claims are dependent claims that include all the limitations of the respective independent claims upon which they depend, and therefore, since the independent claims, as amended, have been shown to be allowable over the cited art, these dependent claims are also allowable over the cited art.

Regarding claims 10 and 16, the Examiner stated that they are rejected for the same reasons set forth to rejecting claim 1 above, since claims 10 and 16 are merely a system for implementing the method defined in the method claim 1. Claims 10 and 16 are independent claims that have been amended in a similar manner to independent claim 1. For the reasons set forth above with regard to the allowability of claim 1, claims 10 and 16, as amended, are also allowable.

The prima facie case of obviousness determination has not been made out. Thus, the opinion of obviousness is deficient and the Applicants are deserving of a patent.

Applicants respectfully submit that the applied references, taken singly or in combination, assuming, arguendo, that the combination of the applied references is proper, do not teach or suggest one or more elements of the claimed invention. Applicants have discussed herein one or more differences between the cited prior art, and the claimed invention with reference to one or more parts of the cited prior art. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of cited prior art correspond to the claimed invention.

Reconsideration and withdrawal of the rejection is therefore respectfully requested. In view of the above remarks, allowance of all claims pending is respectfully requested.

"FROM :

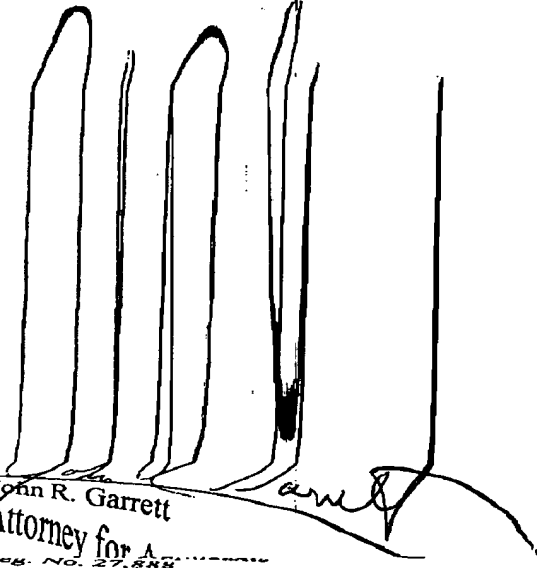
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The prior art made of record and not relied upon is considered to be of general interest only. This application is believed to be in condition for allowance, and such action at an early date is earnestly solicited.

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